

REMARKS

Claims 9-16 and 18-24 are pending in this application. Claims 9-16 were withdrawn from consideration by the Examiner pursuant to a previous restriction requirement. Claims 18-21, 23 and 24 were rejected and dependent claim 22 was indicated as allowable subject matter, if rewritten in independent form. By way of this Amendment, claim 18 has been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification.

Claims 18, 20 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by KR 1999-73868. In the statement of the rejection, the Examiner referred to Fig. 3 of KR 1999-73868, asserting the disclosure of a semiconductor device corresponding to that defined in claims 18, 20, and 24. Applicants respectfully traverse the rejection.

In response to Applicants' Request for Reconsideration filed on April 1, 2004, the Examiner, at pages 4-5 of the Office action, asserted that KR 1999-73868 discloses a grounding conductor layer including a unitary first portion 116 covering an upper surface and two side surfaces of a first wiring 108 and a second portion 112 covering a bottom surface of the wiring 108. The Examiner interpreted the first portion 116 as unitary since it comprises units 116a and 116b. The Examiner relied on the dictionary definition of unitary as being based on or characterized by one or more units.

Applicants have amended independent claim 18 to recite, in pertinent part, that the grounding conductor layer includes a first portion constituted by only one unit covering an

upper surface and two side surfaces of the first wiring and a second portion covering a bottom surface of the first wiring. As acknowledged by the Examiner, KR 1999-73868 discloses a grounding conductor layer including units 116a and 116b, which cover an upper surface and two side surfaces of a first wiring 108 and a second portion 112 covering a bottom surface of the wiring 108. Thus, the present claimed invention, as recited in claim 18, describes that the grounding conductor layer includes a first portion constituted by only one unit covering an upper surface and two side surfaces of the first wiring and a second portion covering a bottom surface of the first wiring. In contrast, KR 1999-73868 discloses a grounding conductor layer including two separate layers or units, namely 116a and 116b. The Examiner's attention is invited to the recent decision of *W.E. Hall Co. v. Atlanta Corrugating, LLC*, ___ F.3d ___, 71 USPQ2d 1135 (Fed. Cir. 2004), wherein the Court of Appeals for the Federal Circuit held that the claim limitation "single piece construction" did not include a multiple piece construction.

As illustrated in Figure 1 of the present disclosure, the grounding conductor layer includes a single unit first portion 19 covering the upper surface and two side surfaces of the first wiring 15 and the second portion 12 covering the bottom surface of the first wiring. In contrast, as illustrated in Fig. 3 of KR 1999-73868, the upper surface of the first wiring 108 is covered with the conductor layer 116b, and two side surfaces of the first wiring 108 are covered with the conductor layer 116a. In other words, the upper surface and the two side surfaces of the first wiring 108 are covered not with a single conductor layer, but with two separate conductor layers (units) 116a and 116b, respectively.

Thus, KR 1999-73868 fails to identically disclose every feature recited in independent claim 18. Accordingly, the above argued structural difference between the

claimed invention and the device of KR 1999-73868 undermine the factual determination that KR 1999-73868 discloses a semiconductor device identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 18, 20 and 24 under 35 U.S.C. § 102 for lack of novelty as evidenced by KR 1999-73868 is not factually viable and, hence, solicit withdrawal thereof.

Claims 19, 21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over by KR 1999-73868. In the statement of the rejection, the Examiner acknowledged that KR 1999-73868 does not disclose a device including a second wiring layer provided over the substrate surface with a second insulator interposed therebetween. The Examiner merely concluded that the duplication of parts to obtain a multiple effect is considered an obvious modification, in order to have greater transmission capacity. This rejection is traversed as factually and legally erroneous.

Initially, Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 18, 20 and 24 under 35 U.S.C. §102 for lack of novelty as evidenced by KR 1999-73868. 19, 21 and 23 are free from the applied art in view of their dependency from independent claim 18. Moreover, the separate patentability of claims 19, 21 and 23 is advocated.

It is well established that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the

art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The Examiner's rejection is based upon an unsupported generalization devoid of any factual basis. Therefore, the above described significant structural difference between the claimed semiconductor device and the semiconductor device of KR 1999-73868 undermines the Examiner's conclusion of obviousness under 35 U.S.C. § 103. Specifically, it is not apparent and the Examiner has not discharged the initial burden of providing any factual basis, as judicially required, upon which to predicate the determination that the duplication of parts would necessarily lead to greater transmission capacity.

Applicants, therefore, submit that the imposed rejection of claims 19, 21 and 23 under 35 U.S.C. §103 for obviousness predicated upon KR 1999-73868 is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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